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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/571,075
Filing Date: September 13, 2007
Appellant(s): ALBARRAN MOYO ET AL.

Steven L. Nichols
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 8/9/2010 appealing from the Office action mailed 4/19/2010.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:
Claims 15-38 are rejected and pending in this application.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

7,623,713 B2

LAPSTUN et al.

11-2009

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 32 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 32 lacks the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material *per se*.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. **Claims 15-22, 31-38** are rejected under 35 U.S.C. 102(e) as being anticipated by Lapstun et al. (US 7,623,713 B2), hereinafter “**Lapstun**”.

As per claim 15, Lapstun teaches a computer program product for generating an electronic document comprising:

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- “a computer usable medium having computer usable program code embodied therewith, the computer usable program code comprising: computer usable program code configured to defined the electronic document” at Col. 7 lines 20-30;
- “in which the computer usable program code comprises first and second portions of data” at Col. 7 lines 20-53;
- “in which the first portion of data defines the content of the electronic document” at Col. 7 lines 20-25;
- “and the second portion comprises data relating to a pattern of position identification marking such that when the electronic document is printed, a pattern reading device is able to determined its position relative to position identification marking” at Col. 9 line 60 to Col. 10 line 13;
- “in which the computer usable program code comprises a single data file with the first and second data portions being embedded within the data file” at Col. 14 lines 11-67.

As per claim 16, Lapstun teaches the computer program product of claim 15 which is written such that the computer usable program code can be converted from one format to other formats without losing any of the information from the electronic document” at Col. 31 lines 25-50.

As per claim 17, Lapstun teaches the computer program product of claim 15, in which “the second portion of data comprises metadata and in which the computer

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useable program code includes one or more controls which control the way in which the second portion of data is converted between formats to preserve the pattern" at Col. 11 lines 20-65 and Col. 31 lines 25-50.

As per claim 18, Lapstun teaches the computer program product of claim 16, in which the second portion of data comprises metadata and in which the computer usable program code includes one or more controls which control the way in which the second portion of data is converted between formats to preserved the pattern" at Col. 11 lines 20-65 and Col. 31 lines 25-50.

As per claim 19, Lapstun teaches the computer program product of claim 15, in which the data in the second portion comprises anyone or more of the following: data from which an algorithm or the like can generate the pattern; co-ordinates or other metadata identifying the portion of the position identification marking" at Col. 12 lines 10-65.

As per claim 20, Lapstun teaches the computer product of claim 16, in which "the data in the second portion comprises anyone or more of the following: data from which an algorithm or the like can generate the pattern; co-ordinates or other metadata identifying the portion of the position identification marking" at Col. 12 lines 10-65.

As per claim 21, Lapstun teaches the computer program product of claim 17, in which "the data in the second portion comprises anyone or more of the following: data

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from which an algorithm or the like can generate the pattern; co-ordinates or other metadata identifying the portion of the position identification marking" at Col. 12 lines 10-65.

As per claim 22, Lapstun teaches the computer program product of claim 18, in which "the data in the second portion comprises anyone or more of the following: data from which an algorithm or the like can generate the pattern; co-ordinates or other metadata identifying the portion of the position identification marking"at Col. 12 lines 10-65.

As per claim 23, Lapstun teaches the computer program product of claim 15, in which "the at least one portion providing the position of the position identification markings within the electronic document and/or data identifying the content of the position identification marking in the electronic document is provided in XML" at Col. 30 lines 5-40.

As per claim 24, Lapstun teaches the program product of claim 16 in which "the at least one portion providing the position of the position identification markings within the electronic document and/or data identifying the content of the position identification marking in the electronic document is provided in XML" at Col. 30 lines 5-40.

As per claim 31, Lapstun teaches the program product of claim 15 in which “a schema is provided” at Col. 30 lines 5-40.

As per claim 32, Lapstun teaches a system for producing electronic documents comprising:

- “mean for receiving the content of the electronic document” at Col. 9 lines 45-55 and Figs. 1, 25-26;
- “means for receiving data defining a pattern of positional markings allocated to at least a portion of the document” at Col. 9 line 66 to Col. 10 line 13;
- “means for generating data structure defining the electronic document which data structure comprises first and second portion of data, the first portion of data defining the content and the second portion of data relating to the pattern” at Col. 14 lines 10-67 and Figs. 1, 25-26.

As per claim 33, Lapstun teaches a method for generating an electronic document comprising:

- “creating an electronic file and storing in that file data and metadata, the data defining at least some content” at Col. 9 lines 45-55 and Figs. 1, 25-26;
- “and the metadata relating to a pattern of position identification markings arranged to allow a pattern reading device to determined its position within the position identification markings” at Col. 9 line 66 to Col. 10 line 13,

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- “the electronic file capable of generating an electronic document” at Col. 14 lines 10-67 and Figs. 1, 25-26.

As per claim 34, Lapstun teaches the method of claim 33, in which “a file embedding mechanism is used to embed metadata within the electronic document” at Col. 11 lines 20-65.

As per claim 35, Lapstun teaches the computer program product of claim 15, in which “the pattern reading device is a digital pen” at Col. 12 lines 12-22.

As per claim 36, Lapstun teaches the method of claim 33, in which “the pattern reading device is a digital pen” at Col. 12 lines 12-22.

As per claim 37, Lapstun teaches the computer program product of claim 31, in which “the schema is an XML schema” at Col. 30 lines 5-12.

As per claim 38, Lapstun teaches the method of claim 34, in which “the metadata is XML metadata” at Col. 30 lines 5-12.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 23-30** are rejected under 35 U.S.C. 103(a) as being unpatentable over Lapstun as applied to claims 15-22, 31-38 above, and in view of Ethier et al. (US 7,653,876 B2), hereinafter "**Ethier**".

As per claim 23-30, Lapstun does not teach "the second portion of data is provided in XML" as claimed. However, Ethier teaches an electronic document includes a first portion and a second portion, wherein a second portion is provided in XML at Col. 3 lines 30-50. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine Ethier with Lapstun so that "the document can be transformed back and forth between a binary format and a markup language format without loss of desired information" as suggested by Ethier at Col. 4 lines 58-65.

(10) Response to Argument

Summary of Appellant's invention.

Appellant's Fig 1 reproduced below is an example of the electronic document generated by Appellant's invention, which comprises a first portion of data defines the content of the electronic document (i.e. 109, 118, 124, 121, 122) and a second portion (i.e. 108) comprises data relating to a pattern of position identification marking. Fig. 2 shows the position identifier pattern 108 is made up of a number of dots 103 to be read by a sensor 316 as shown in Fig. 3 to determine the location of the sensor on the document.

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Comments

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109

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GOOD 124

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BAD

V. BAD

SEND

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Further Comments

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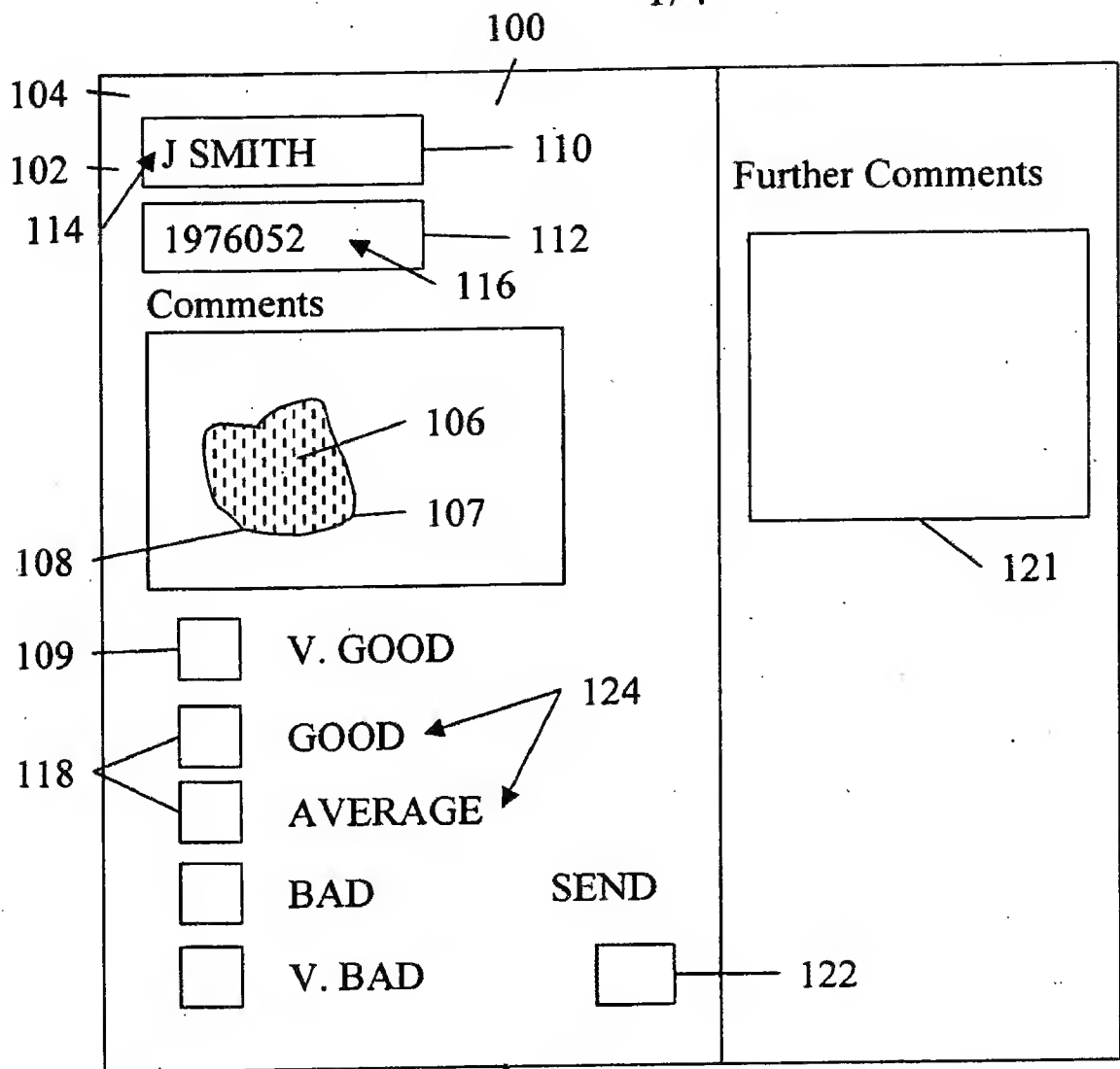
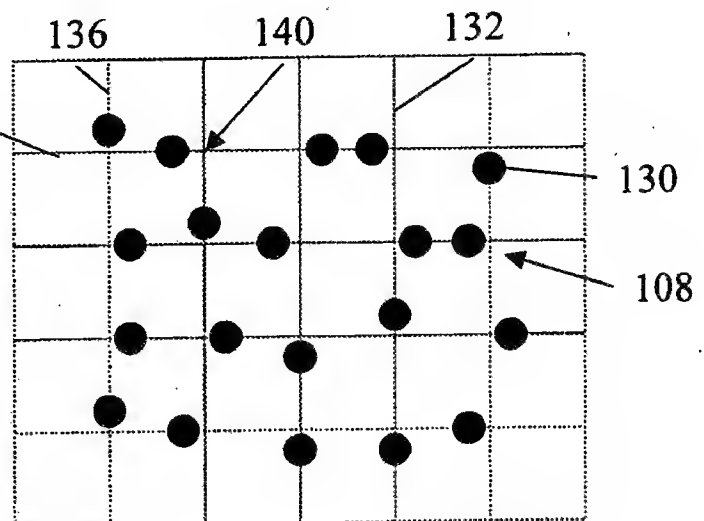


Fig 1

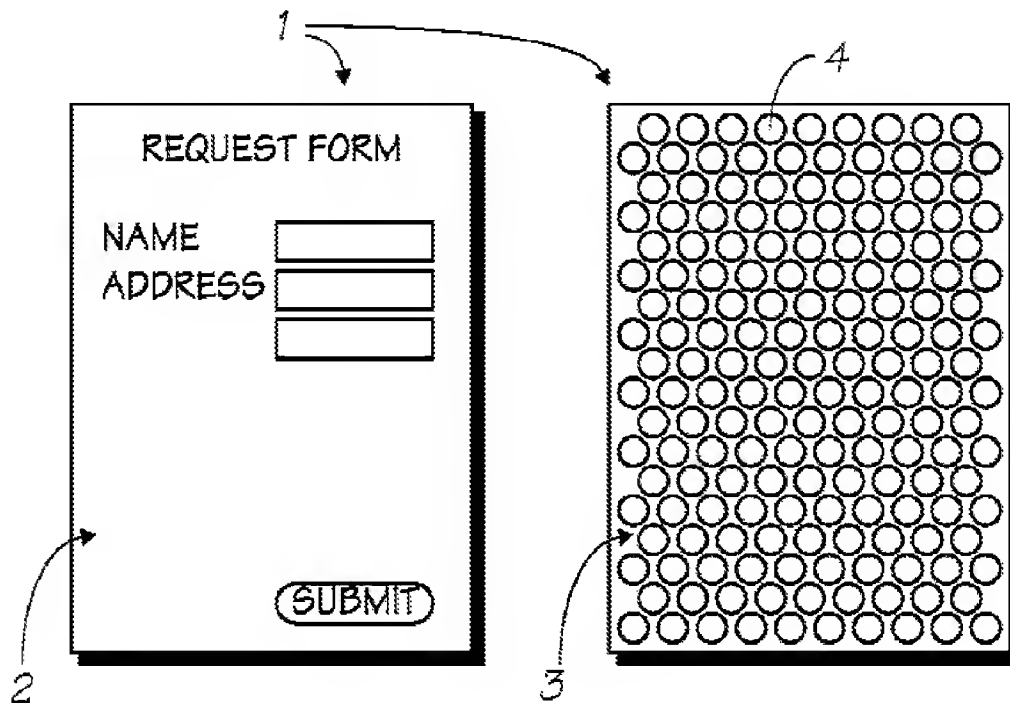
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Fig 2



Summary of Lapstun reference

Lapstun teaches an electronic document to be printed , comprising a first portion (2) of data defining the content of the electronic and a second portion (3) comprising coded data which indicates position of a sensing device relative to the document .



1. The rejection of claim 32 under 35 U.S.C § 101.

Regarding claim 32, Appellant argued that the claim contain physical article or objects to constitute a machine or manufacture within the meaning of 35 U.S.C 101. Appellant refers to the specification at page 2 line 28 through page 3 line 4 and page 19 lines 19-31 to provide support for the mean plus function. However, the specification at page 2 and 3 does not teach a “processing apparatus” as quoted by Appellant, and page 19, lines 19-31 does not disclose "a printer" as quoted by Appellant. Further, even

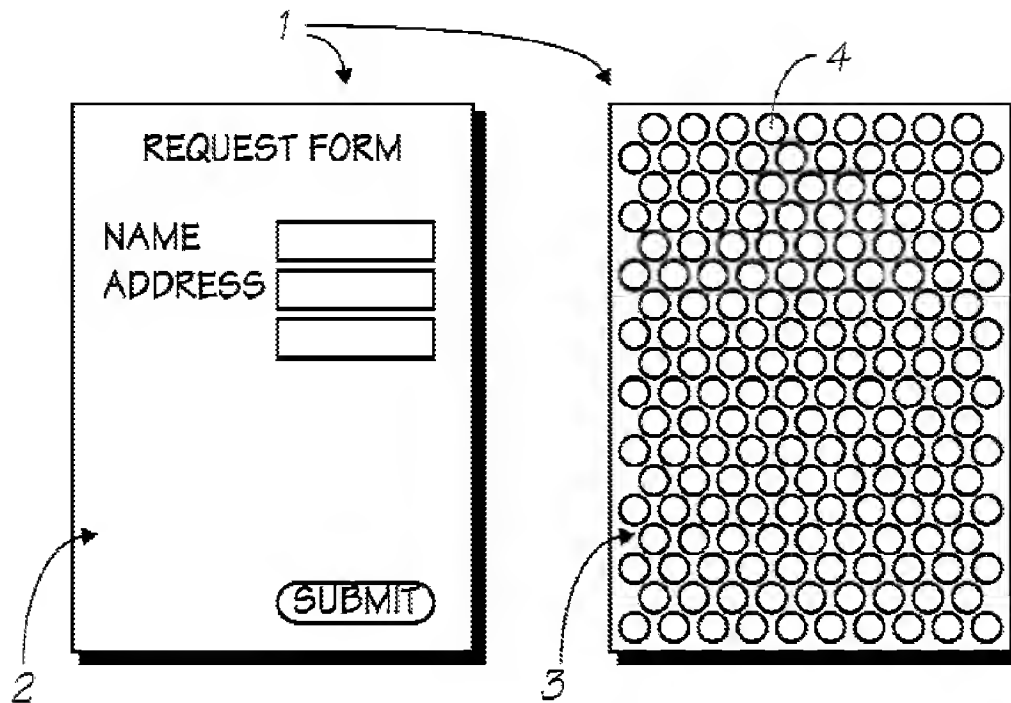
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if the “processing apparatus” and “a printer” are hardware, they are not utilized to perform the function as recited in the claims. Therefore, the claimed system recited in claim 32 is software per se, lacks the physical article or objects to constitute a machine or manufacture within the meaning of 35 U.S.C 101.

2. Rejection of claims 15-22 and 31-38 under 35 U.S.C §102(e) as being anticipated by Lapstun

Claims 15 and 33:

Regarding claims 15, 33, applicant argued that “Lapstun is silent on providing a single data file that includes these terminal elements within the data file”. On the contrary, Lapstun clearly teaches at Col. 14 lines 11-67 the **page instance 830** (i.e. “**single data file**”), which consists of “a set of terminal element instance” and the “Page ID 50” encoded in tags. Lapstun further teaches: “each page instance 830 describes a single unique printed netpage 1, and record the page ID 50 of the netpage” at Col. 14 lines 45-46. As seen at Fig. 1 reproduced below, each netpage is the printed copy of the page instance 830, and includes first portion (element 2 of Fig. 1) of data defining content of the document and a second portion (element 3,4 of Fig. 1) comprising data relating to a pattern of position identification markings as claimed.



In the Appeal Brief at page 14, Appellant argued that “Lapstun simply teaches that printed netpage includes graphic data printed on the netpage as visible elements and coded data printed on the netpage as invisible elements, but is silent as to how the graphic data and coded data are electronically stored or otherwise brought together within the printed netpage”. On the contrary, as discussed above, Lapstun generates a page instance 830 which comprises graphic data and coded data before sending to the printer to output the paper document containing both data. Lapstun's page instance therefore corresponds to the claimed "single data file" with the first and second data portions being embedded within the data file as claimed.

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Claim 32:

Regarding claim 32, Appellant argued that "Lapstun is silent on creating a single data file that includes content of the electronic document and data relating to a pattern of position identification marking", it is noted that the features upon which applicant relies (i.e., "creating a single data file") are not recited in the rejected claim 32. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). On the other hand, as discussed above, Lapstun teaches the **page instance 830** (mapped to the claimed "**data structure**") comprise first and second portions of data and therefore anticipated the claimed limitation.

Claims 17 and 18:

Regarding claims 17 and 18, Applicant argued that Lapstun only teaches converting the document from one format to another but does not teach "converting a second portion of data comprising metadata from one format to another". On the contrary, the examiner respectfully submits that Lapstun document includes first and second portions of data, therefore, converting the document from one format to another format is same as converting second portion of data from one format to another format as claimed.

Claims 19-22:

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Regarding claim 19-22, Applicant argued that Lapstun does not teach or suggest "in which the data in the second portion comprises any one or more of the following: data from which an algorithm can generate the pattern; co-ordinates or other metadata identifying the portion of the position identification marking". On the contrary Lapstun teaches at Col. 12 lines 10-16 that each of the tag (i.e. "data in the second portion") is encoded with data which is used to identifying the portion of the position identification marking (i.e. scale, aspect ration, rotation, axis, spatial relationship, distortion etc.") Lapstun therefore teaches that the second portion comprise "other metadata identifying the portion of the position identification marking as claimed.

3. Claims 23-30 are rejected under 35 U.S.C 103(a) as being unpatentable over Lapstun and Ethier.

Regarding claim 23, in response to Appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

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In this case, Lapstun does not teach "the second portion of data is provided in XML" as claimed. However, Ethier teaches an electronic document includes a first portion and a second portion, wherein a second portion is provided in XML at Col. 3 lines 30-50. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine Ethier with Lapstun so that "the document can be transformed back and forth between a binary format and a markup language format without loss of desired information" as suggested by Ethier at Col. 4 lines 58-65.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Khanh B. Pham/

Primary Examiner

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